

REMARKS

To promote administrative efficiency and better communication, the Examiner is invited to make suggestions at any time during the proceedings, on or off the record, via phone, fax or e-mail, whenever such suggestions are within the Examiner's discretion as an aid to placing the claims in order for allowance in a timely manner.

Restriction requirement:

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SEP 07 2001

1. Applicant has been required to elect for further prosecution one of four **GROUP 3700** inventions under the suggestion of the Examiner that:
- I. Claims 1-5 and 7-9 are drawn to a punching device with specific punch support structure, classified in class 83, subclass 687.
 - II. Claims 1 and 6 are drawn to a punching device with specific drive mechanism, classified in class 83, subclass 628.
 - III. Claims 1 and 10 are drawn to a punching device with a suction removal device, classified in class 83, subclass 100.
 - IV. Claim 11 is drawn to a method of invalidating plane objects, classified in class 83, subclass 13.

In response to this requirement, applicant provisionally elects the invention identified as group I: Claims 1-5 and 7-9, with traverse.

2. Restriction is proper when two or more independent and distinct inventions are claimed in one application. 35 U.S.C. 121; 37 C.F.R. 1.142.

It is respectfully submitted that the inventions as defined by the Examiner are not independent and that they have common design and operational features.

Apparatus Groups

3. Regarding inventions defined by groups I and II, the Examiner suggests that they are separate and distinct inventions because invention of group I does not require the details of group II as evidenced by the omission thereof from group I, and the invention of group II does not require the details of group I as evidenced by the omission thereof from group II. Is it the Examiner's position that these inventions are patently distinct, i.e. novel and non-obvious over each other as claimed ? If not, a restriction requirement is improper. M.P.E.P. §802.01

Further, according to the Applicant, the omission mentioned by the Examiner is a direct consequence of the definition of different inventions suggested by the Examiner. Claim 6 (alleged Invention II) defines "The device as claimed in claims 1 to 5, wherein the drive mechanism comprise a hydraulic cylinder (01), which by means of an eccentric shaft (02) moves the pressing plate (13) downward between running rollers (05) against the objects (14) to be invalidated". The feature "drive mechanism" mentioned in claim 6 is defined in claim 1 as the means "by which the die plates can be displaced up and down" (see line 6 of claim 1) and said die plates are further defined in claims 4 (see line 1) and 5 (see line 1). In addition, claim 6 mentions a pressing plate (see line 3), said pressing plate being also mentioned in claims 4 (see lines 2-3) and 5 (see lines 2-3).

Therefore it is submitted that claim 6 defines common design and operational features between at least claims 1, 4 and 5 so that the election requirement is not justified and claim 6 belongs to the same as claims 1, 4 and 5.

4. Regarding inventions of groups I and III, the Examiner suggests that they are separate and distinct inventions because invention of group I does not require the details of group III as evidenced by the omission thereof from group I, and because invention of group III does not require the details of group I as evidenced by the omission thereof from group III. Is it the Examiner's position that these inventions are patently distinct, i.e. novel and non-obvious over each other as claimed ? If not, a restriction requirement is improper.

Applicant submits that the omission mentioned by the Examiner is a direct consequence of the definition of different inventions suggested by the Examiner.

However, amended claim 10 now depends directly from claim 9, it is respectfully submitted that this direct dependency creates the necessary common design and operational features between invention of groups I and III. Therefore the election requirement is no longer justified.

5. Regarding inventions of groups II and III, the Examiner suggests that they are separate and distinct inventions because invention of group II does not require the details of group III as evidenced by the omission thereof from group II, and because invention of group III does not require the details of group II as evidenced by the omission thereof from group III. Is it the Examiner's position that these inventions are patently distinct, i.e. novel and non-obvious over each other as claimed? If not, a restriction requirement is improper.

Applicant submits that the omission mentioned by the Examiner is a direct consequence of the definition of different inventions suggested by the Examiner. In addition, as explained above, since inventions of groups I and II are not separate inventions, it is submitted that invention of group III possesses the necessary common design and operational features to belong to group I.

Method Group v. Apparatus Groups

6. According to the Examiner, (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process, for example for performing various types of known punching processes: the inventions of groups I-III and group IV are therefore distinct.

Applicant questions whether such apparatus having the limitations necessary for performing the claimed process would in fact be materially different. Further, the steps "displacing die plates onto the products to be invalidated" and "invalidating the product by the paper drills", "lifting the die plates off and pulling the paper drills out of the invalidated products" as required in the claimed method do not appear to be steps that can meaningfully be conducted by hand.

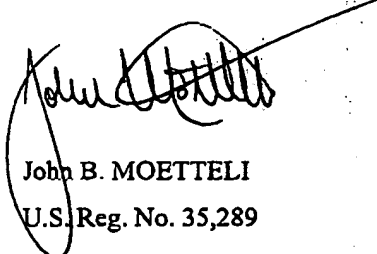
In addition, is it the Examiner's position that these inventions are patently distinct, i.e. novel and non-obvious over each other as claimed? If not, a restriction requirement is improper.

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Applicant respectfully submits that no new matter has been entered by this amendment. If the Examiner believes that this response is incomplete or otherwise unresponsive, it is requested that a telephone call be placed to the undersigned in order to expedite the disposition of this case at phone 011-4122-346-8744, fax at 011-4122-346-8960 (Geneva is 6 hours ahead of Eastern Std Time), or e-mail at moeteli@bugnion.ch. Any limitations to the claims are made solely for the purpose of expediting the prosecution of the application and, unless otherwise expressly stated, are not made to narrow, vis-à-vis the prior art, the scope of protection which any subsequently issuing patent might afford.

Respectfully submitted,
BUGNION S.A.

Date : Sept 7, 2001



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Enclosures: clean copy of amended claim

CLEAN COPY OF THE AMENDED CLAIM:

AC 10. (amended) The device as claimed in claim 9, wherein the paper scrap is removed from the container (03) by means of a suction removal device.
